Remarks/Arguments

Reconsideration of this application is requested.

Claim Status

Claims 1-56 were presented. Claims 1, 10, 17, 18, 26, 32, 37, 44, 50 and 51 are amended. Claims 9, 16, 25, 27, 43, 49 and 56 are canceled. New claim 57 is added. Thus, claims 1-8, 10-15, 17-24, 26, 28-42, 44-48, 50-55 and 57 are now pending.

Claim Rejections – 35 USC 112

Claims 10, 18, 44 and 51 are rejected under 35 USC 112, second paragraph, for indefiniteness. Claims 10, 18, 44 and 51 are amended to recite more clearly the statutory class of an apparatus, as discussed in detail below, with respect to the 35 USC 101 rejections.

For these reasons, the rejections under 35 USC 112 should be withdrawn.

Claim Rejections – 35 USC 101

Claims 1-56 are rejected under 35 USC 101, as being directed to non-statutory subject matter.

Method claims 1-8 and 26-42, as amended, recite more clearly a statutory process under 35 USC 101. In particular, amended independent claims 1, 26, 32 and 37 recite the transformation of underlying subject matter to a different state or thing. For example, claim 1 recites the creation of an electronic backup copy of data of a third entity onto a storage medium of a second entity. The storage medium of the second entity is thus transformed into a different state according to the agreements between the different entities. The transformation of data in the storage medium is clearly a change in a physical object that is not a manipulation of a legal obligation or relationship. Independent claims 26, 32 and 37 are amended in

a similar to claim 1. Support for the amendments is found, inter alia, in applicant's published application at paragraphs [0020], [0022] and FIG. 1.

Independent claims 18 and 51 are amended to recite a data protection service provider device so as to provide a clear indication of the statutory class of the invention. This feature finds support in at least applicant's paragraph [0022], where the data protection service provider is an online data backup service that is clearly a physical device. Therefore, independent claims 18 and 51 are directed to the statutory class of an apparatus. Thus, claims 18-24 and 51-55 are directed to statutory subject matter.

Similarly, independent claims 10 and 44 now recite storage mediums of the data protection service provider and insured entity such that claims 10-15, 17, 44-48 and 50 are not directed to an insurance agreement per se.

In view of these amendments, the rejections of claims 1-56 under 35 USC 101 should accordingly be withdrawn.

Double Patenting

Claims 1-8 are provisionally rejected under statutory double patenting as claiming the same invention as that of claims 1 and 3-9 of copending application no. 10/739,931.

In response, applicant respectfully traverses the rejection as the claims of the instant application and claims 1 and 3-9 of copending application no. 10/739,931 do not recite identical subject matter, as is required under MPEP 804. When the conflicting claims are not the "same", a double patenting rejection on statutory grounds is improper. Thus, applicant respectfully submits that the provisional statutory double patenting rejections be withdrawn.

Claim Rejections – Conn

Claims 1-56 are rejected under 35 USC 102(e) as being anticipated by Conn (US 2005/0137911).

In view of the enclosed Declaration under 37 CFR 1.132, applicant respectfully traverse the rejection. The Declaration establishes that those portions of copending application no. 10/739,931 that are relevant to the patentability of the claims of this application originated with inventors John Paul Conn and Thomas J. O'Brien. Thus, the relevant portions of application no. 10/739,931 are derived entirely from applicant's own work and not by another.

Accordingly, the rejections under 35 USC 102(e) should be withdrawn.

Claim Rejections – McCabe

Claims 1-31 and 37-56 are rejected under 35 USC 102(b) as being anticipated by McCabe (US 2002/0095317). Claims 32-36 are rejected under 35 USC 103(a) as being obvious over McCabe in view of Official Notice. In response, independent claims 1, 10, 18, 26, 32, 37, 44 and 51 are amended to distinguish more clearly McCabe.

Claims 1-25 and 37-56

The present invention is directed to restoring electronic data after a loss of data and data insurance. Claim 1, as amended, recites a method including creating an agreement between a first entity, wherein the first entity purchases a data protection service from the second entity for data stored on a storage medium of the third entity. An insurance agreement is created between the first entity and the third entity. The insurance agreement provides that the first entity will insure that the third entity for losses arising out of lost data and authorizes the third entity to use the data protection service provided by the second entity. An electronic backup

copy of the third entity's data by the data protection service is created on a storage medium of the second entity according to the agreements.

Importantly, the insurance agreement specifies that the third entity does not pay a premium to the first entity, beyond what the first entity would charge for providing insurance without the data protection services. As shown in FIG. 2, the first entity insurer 110 provides data protection services on behalf of its insured customers 130. First entity insurer 110 compensates second entity 120 for providing the data protection service to insured 130. However, insurer 110 does not charge the insured 130 any special or additional premium beyond those normally charged for insurance without data protection service (paragraphs [0024], [0032]). Furthermore, as disclosed in paragraph [0031], many insureds will forego the extra expense of acquiring data protection services. The present invention, by contrast, provides an insured a substantial incentive to maintain and use the data protection service by not increasing the premium to use the data protection services. Thus, by increasing the number of insureds that use the data protection service, the insurance provider can reduce the amount it must pay out in claims for data loss (paragraph [0033]). McCabe does not operate in this manner.

McCabe discloses in the Abstract, paragraph [0025] and FIG. 4 that the insurance premium paid by an insured is based in part on the technical protection services provided. Specifically, the insurance premium is calculated based on "an expected technical data protection service employed." Therefore, the insured pays a premium that includes the data protection services that goes beyond a premium that would be paid for insurance that did not include data protection services.

In view of this significant difference, independent claims 1, 10, 18, 37, 44 and 51 are amended to recite that the insured does not pay for the data protection

service beyond what is charged for insurance without the data protection service. For example, claim 1 is amended as follows:

> ... *the third entity does not pay a premium to the first entity, beyond what the first entity would charge for providing insurance without the data protection services* ...

Since McCabe does not disclose each and every feature of independent claims 1, 10, 18, 37, 44 and 51 it cannot anticipate those claims or claims 2-8, 11-15, 17, 19-24, 38-42, 45-48, 50 and 52-55 dependent thereon. The rejections of claims 1-25 and 37-56 under 35 USC 102(b) should be withdrawn.

Claims 26-31

Independent claim 26 is directed to a method for providing data insurance and data protection services based on agreements between an insurer, insured and data protection service provider. Importantly, the insurance agreement specifies that the premium for the insurance will be reduced if the insured uses the data protection service. McCabe fails to disclose or suggest this feature.

Although McCabe provides a plurality of factors used to calculate an insurance premium, there is no comparison provided between premiums where the data protection service is used by the insured versus where the data protection service is not used by the insured. Therefore, McCabe does not teach how premiums differ based on the usage and non-usage of the data protection service. Thus, the reduction of a premium based on usage of the data protection service is not disclosed.

Since McCabe does not disclose each and every feature of claim 26, it cannot anticipate claim 26 or claims 27-31 dependent thereon. The rejections of claims 26-31 under 35 USC 102(b) should be withdrawn.

Claims 32-36

Amended independent claim 32 is directed to a method including an agreement between the insurer and data protection service to provide compensation from the data protection service provider to the insurer for the insurer's request that the insured use the data protection service. Page 12 of the Office Action concedes that McCabe fails to teach the feature of "compensation from the data protection service provider to the insurer for the insurer's requirement that the insured use the data protection service." Thus, the rejections of claims 32-36 under 35 USC 102(b) should be withdrawn.

New Claim

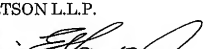
New claim 57 is added to better define the invention and finds support in original claim 32.

Conclusion

This application is now believed to be in condition for allowance. The Examiner is invited to telephone the undersigned to resolve any issues that remain after entry of this amendment. Any fees due with this response may be charged to our Deposit Account No. 50-1314.

Respectfully submitted,
HOGAN & HARTSON L.L.P.

Date: April 23, 2009

By: 
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